

REMARKS

This paper is filed in response to the final office action mailed on June 3, 2005. Claim 5 has been canceled and combined with claim 1. Claims 1, 3-4, 9-11, 15-28, and 38-41 are currently pending.

Applicant earnestly solicits the entry of this amendment under Rule 116 because it raises no new issues, reduces the total number of pending claims and places all claims in a condition for allowance. Specifically, claim 5 has been canceled and a shortened Markush group of claim 5 has been combined with amended claim 1. The possibility that the Markush group of now-canceled claim 5 covers a polyvinyl acetate has been eliminated as "poly(vinyl esters)" has been deleted from the Markush group added to claim 1. Thus, claim 1 is now allowable over any hypothetical combination of Krall and Slaikeu as the Patent Office admits that Krall does not teach or suggest a polymeric non-cyanoacrylate rheology modifying agent and Slaikeu only teaches a partially hydrolyzed polyvinyl acetate polymer and therefore Slaikeu does not teach or suggest a rheology modifying agent selected from the Markush group of amended claim 1. Therefore, no combination of Krall and Slaikeu teaches or suggests every element of amended claim 1 and the pending obviousness rejection is improper and should be withdrawn.

Claims 1, 3-4, 9-11, 15-28, and 38-41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Krall in view of Slaikeu. Applicant respectfully submits that this rejection is improper because no combination of Krall and Slaikeu establishes a *prima facie* case of obviousness.

Under M.P.E.P. §§ 2142 and 2143, to establish a case of obviousness, three criteria must be met. First, there must be a suggestion or motivation in the references cited or in the general knowledge of the art to modify the references or combine the teachings of the references. Second, there must be a reasonable expectation for success that the proposed modification or combination would work. Third, the proposed combination of references must teach or suggest all of the claim limitations.

Applicant respectfully submits that no combination of Krall and Slaikeu fails to teach or suggest every limitation of the claims and, further, that there is no suggestion or motivation to combine Krall and Slaikeu in the manner set forth in the final office action. Hence, the proposed combination fails to establish a *prima facie* case of obviousness, for at least two reasons.

Amended claim 1 recites a medical composition comprising (1) a matrix-forming component of alkyl cyanoacrylate monomers, a stabilizer, and a plasticizer; (2) a solid aggregate material that includes a radiopacifier; and (3) a polymeric non-cyanoacrylate rheology modifying agent with a molecular weight greater than 200,000 selected from a Markush group that does not include poly(vinyl acetate).

Krall teaches of an embolic composition comprising an alkyl cyanoacrylate monomer, at least one inhibitor, an alkyl esterified fatty acid and an opacificant agent. The Patent Office admits at page 4 of the Office Action that Krall does not teach or suggest the use of a polymeric non-cyanoacrylate rheology modifying agent having a molecular weight of greater than 200,000.

The Patent Office then looks to Slaikeu to supplement this deficiency of Krall. However, Slaikeu only teaches an embolic composition comprising a liquid solution of partially hydrolyzed polyvinyl acetate polymer that precipitates and agglomerates, along with a pharmaceutically acceptable solvent and optionally a radiopacifier. Amended claim 1 recites a Markush group that does not include polyvinyl acetate and therefore Slaikeu cannot supplement the deficiencies of Krall in the manner suggested by the Patent Office.

Therefore, no combination of Krall and Slaikeu teaches or suggests every element of amended claim 1 and therefore no *prima facie* case of obviousness exists based upon any hypothetical combination of Krall and Slaikeu.

Further, applicant respectfully submits that there is no motivation or suggestion to combine Krall and Slaikeu in a manner proposed by the Patent Office. Slaikeu only teaches a partially hydrolyzed solution of polyvinyl acetate polymer in an appropriate solubilizing solvent, not as a rheology modifying agent. Thus, not only Slaikeu fail to teach or suggest a rheology modifying agent, does not teach or suggest the Markush group of amended claim 1. Therefore, not only does the polymer of Slaikeu have to be modified but its end use has to be modified in order to make an appropriate combination with Krall to establish a *prima facie* case of obviousness. The reasons for the impropriety of this combination are set forth in the amendment filed on March 9, 2005.

The Patent Office also rejects claims 1, 3-4, 9-11, 15-28 and 38-41 under 35 U.S.C. § 103 as being unpatentable over Krall, Slaikeu and further in view of Hechenberger. However, Hechenberger is only cited for the proposition that it teaches the use inorganic particulate material. Hechenberger does not teach or suggest the non-cyanoacrylate rheology

modifying agent of amended claim 1 and therefore no combination of Krall, Slaikeu and Hechenberger teaches or suggests every element of amended claim 1 and therefore no combination of these three references can establish a *prima facie* case of obviousness.

Further, Hechenberger merely teaches of a cyanoacrylate monomer combined with an alkyl acrylate, fumed silica and a polymerization stabilizer for use as an instant adhesive composition. The function of this adhesive is for industrial purposes, and for use on "porous substrates such as paper, cardboard, leather, and wood." See column 1, lines 14-15 and 23-27. The current application is concerned with *medical* applications of modified and supplemented cyanoacrylate matrices. There is no motivation or suggestion to combine the teachings of Hechenberger with either Krall or Slaikeu. Even if combined, the various teachings would not establish a *prima facie* case of obviousness, as none of the documents discuss the use of a rheology modifying agent to increase the viscosity of the mixture to form a better embolic composition.

In view of the above arguments, it is submitted that the pending application is in condition for allowance and an early action so indicating is respectfully requested.

The Commissioner is authorized to charge any fee deficiency required by this paper, or credit any overpayment, to Deposit Account No. 13-2855.

Dated: July 6, 2005

Respectfully submitted,

By 

Michael R. Hull

Registration No.: 35,902

MARSHALL, GERSTEIN & BORUN LLP

233 S. Wacker Drive, Suite 6300

Sears Tower

Chicago, Illinois 60606-6357

(312) 474-6300

Attorney for Applicant